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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/365,576

08/02/1999

DAVID MOORE

00786/246002

1944

7590

04/23/2002

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EXAMINER

PAK, MICHAEL D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 04/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/365,576

Applicant(s)

Moore et al.

Examiner

Michael Pak

Art Unit

1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 17, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) 1-6, 8, 9, 11, 12, and 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10, 13-16, and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment filed 17 January 2002 (Paper No. 15) has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicant's arguments filed 17 January 2002 (Paper No. 15), have been fully considered but they are not found persuasive.
4. This application contains claim 37 is drawn to an invention non-elected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) MPEP § 821.01.

Claim Rejections - 35 USC § 101

5. Claims 7, 10, 13-16 and 27-31 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a substantial or specific asserted utility or a well established utility.

The reasons for the rejection has been set forth in the previous office action.

Applicants argue that the inhibitory action of RIP-15 on RXR

would provide utility for diseases associated with RXR such as hyperthyroidism because thyroid hormone receptor heterodimerizes with RXR. However, no evidence is provided that RIP-15 can inhibit thyroid hormone receptor in hyperthyroidism.

Furthermore, no compounds which increase RIP-15 expression is taught in the specification. Applicants further argue that antibodies to RIP-15 can be used to detect or monitor RXR-related diseases. However, no evidence has been provided that RIP-15 antibodies can be used to detect hyperthyroidism.

Claims 7, 10, 13-16 and 27-31 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112, 1st paragraph

6. Claims 7, 10, 13-14, 16, 27, 28 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Written description

rejection.

Claims 7, 10, 13-14, 16, 27, 28 and 31 encompass a peptide variant because of recitation of percent identity. However, the specification only discloses working example of species of RIP-15 but do not disclose a working example of the genus of other amino acids. *University of California v. Eli Lilly and Co. (CAFC) 43 USPQ2d 1398* held that a generic claim to human or mammalian when only the rat protein sequence was disclosed did not have written description in the specification. The essential feature of the invention is the RIP-15 of SEQ ID NO:3. No functional limitation can limit the structural limitation because the receptor is an orphan receptor.

Claim Rejections - 35 USC § 102

7. Claims 7, 10, 13-14, 16, 27, 28 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Liao et al. (US 5,639,616).

Liao et al. disclose ubiquitous nuclear receptor which is 97.1% identical to SEQ ID NO:3 and thus meets the claim limitations directed percent identity of claims 7, 10, 13, 15-16, 27, 28, and 31.

The ubiquitous receptor has the identical amino acid sequence as the DNA binding region of SEQ ID NO:5 and thus inherently binds the DNA response element of RARE and ECRE. The ubiquitous receptor inherently binds the RXR. Liao et al. teach

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the human receptor of ubiquitous receptor (column 12) which meets the claim 14 limitation drawn to derived from human.

8. No claims are allowed. SEQ ID NO: 3 is free of the prior art.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0234.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Michael D Pak

Michael Pak
Primary Patent Examiner

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14 April 2002